

REMARKS

The Final Office Action mailed on July 25, 2006, considered and rejected claims 1-15 and 25-37. Claims 26-31 and 33-37 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-15 and 25-37 were rejected under 35 U.S.C. § 102(e) as being anticipated by Chan, *et al.*, (US 6,799,718) (hereinafter "*Chan*").¹

By this amendment, claims 1, 9, 25, and 32 are amended. Claims 1-15 and 25-37 remain pending. Claims 1, 9, 25, and 32 are independent claims which remain at issue.

It should be noted that the present invention is directed generally towards methods and products for permitting a programmer to edit multilanguage documents using the editing functionality of a primary editor for the primary language and one or more secondary editors with advanced editing functionality to edit sections of the multilanguage document written in secondary languages. *See Specification ¶¶ 8-12.* In contrast, *Chan*, which is cited as anticipating the present invention, provides development assistance for mixed-language sources by teaching the use of parsers and scanners by which a user may be assisted in editing the secondary language sections of a mixed-language source through a single primary editor. *See, generally, Chan.*

Concerning the rejection of claims 26-31 and 33-37 under 35 U.S.C. § 112:

Initially, it will be noted that claims 26-31 are dependent claims reciting the "computer program product as recited in claim 25" and claims 33-37 are dependent claims reciting a "computer program product as recited in claim 32". However, claims 25 and 32, inadvertently recited methods rather than computer program products. Accordingly, claims 25 and 32 have been amended by this response to appropriately recite the intended computer program products. In view of these amendments, the indefiniteness rejections are now moot.

Concerning rejection of claim 1 under 35 U.S.C. § 102(e):

The Examiner cites to *Chan* for anticipation of all the elements of claim 1. There are, however, distinct differences between *Chan* and the present invention which prevent *Chan* from anticipating or making obvious the claimed invention.

In *Chan* a "scanner" and "parser" are utilized to "provide syntax indication" within the primary editor and which can be used to "convert" secondary language code sections. Notably, however, *Chan* never teaches using a secondary editor to *edit* secondary language sections of a multilanguage document

¹ Although the prior art status of the cited art is not being challenged at this time, Applicant reserves the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

while remaining within the primary application view, as recited in the pending claims in combination with the other recited claim elements. Furthermore, *Chan* teaches using a “scanner” or “parser” to highlight key terms or provide syntax indication for secondary languages but *Chan* does not teach the ability to incorporate an editor, specialized and optimized for editing secondary language sections, within a primary editor’s primary application view.

Those skilled in the software development arts and those skilled with editors will appreciate that syntax indication and highlighting of key terms is but a small subset of the functionality of a specialized editor. By providing a mechanism for incorporating a secondary language editor within a primary editor’s primary application view, the present invention provides useful and innovative functionality not taught by *Chan*. Parsed and converted text which is then edited by the primary editor, as taught by *Chan*, does not embody all the functionality and utility of the innovation taught by the present invention and as clarified by at least the amendments made by this paper.

In particular, claim 1 and the other independent claims² have been amended to more particularly point out that a user interacts with a secondary editor to edit secondary language sections of a multi-language document but that the interaction and display is handled seamlessly within the primary view of the primary application. The Applicant believes that claim 1, with these amendments, clearly points out innovation and utility that is neither taught nor suggested by *Chan*. Accordingly, claim 1 and the other independent and dependent claims should now be found in condition for prompt allowance for at least these reasons.

Concerning rejection of claim 9 under 35 U.S.C. § 102(e):

Furthermore, with specific regard to claim 9, Applicant respectfully notes that a claim is anticipated under 35 U.S.C. § 102(a), (b), or (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.³ Further, the identical invention must be shown in as complete detail as is contained in the claim.⁴ Finally, the elements must be arranged as required by the claim. MPEP § 2131.

Notwithstanding the foregoing, it is notable that while the Examiner relies on *Chan* to anticipate claim 9 under 35 U.S.C. § 102(e), it has not even been asserted that all of the claim elements recited in claim 9 are taught by the cited disclosure of *Chan*. For example, it has not been asserted that *Chan*

² Claims 9, 25, and 32 have also similarly been amended as the rejections of those claims followed, at least in part, the rejection of claim 1.

³ See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

⁴ See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

teaches or suggests, among other things, "editing functionality provided by the secondary editor."⁵ Furthermore, claim 9 recites that "at least one code segment ... can be recognized and *edited* by the secondary editor." (Emphasis added.) In this regard, it will again be noted that *Chan* teaches only that editing is done by the primary editor.⁶ Accordingly, without each and every element of claim 9 having been taught by *Chan*, a *prima facie* rejection under 35 U.S.C. § 102(e) cannot be sustained and withdrawal of the rejection is therefore requested.

Furthermore, to the extent that the Examiner has indicated that "it is inherent in the disclosure of *Chan* that such a mapping would enable the primary editor to modify the multilanguage file in response to a change made to the secondary document . . ." Applicant respectfully notes that the Examiner must provide rationale or evidence tending to show inherency. *See MPEP* § 2112. In this instance, there does not appear to be adequate rationale or evidence to establish the purported inherency. In fact, contrary to the present invention, which recites that a secondary editor is employed to edit sections of a multilanguage file written in a secondary language, *Chan* teaches that the primary editor is used to edit the file. In addition, *Chan* teaches away from changes being made to the secondary file. In the sections cited by the Examiner, *Chan* specifically states that only those portions of the multilanguage file which *do not require conversion* are accumulated in the "separate location (e.g., file or buffer)." *See Chan* col. 7, lines 45–51; *see also Chan* col. 8, lines 12–14 ("If the code does not require conversion . . . the section of code is . . . placed in a buffer"). As the present invention teaches both an editor separate from the primary editor and which contains functionality not contained by the primary editor and because *Chan* actually teaches away from changes being made to code accumulated within a separate file, it should not be considered inherent that *Chan* contains each and every element of the present invention as particularly claimed in claim 9.

Notwithstanding the inadequate rejection of claim 9, claim 9 has nonetheless been amended to more particularly point out the limitations mentioned above with regard to the separate editor of claim 1, containing functionality specific to the secondary language, to promote consistency and clarity of the claimed embodiments. In view of the foregoing and because *Chan* does not teach each and every element of the present invention as claimed in claim 9, the current rejections under 35 U.S.C. § 102(e) should now be withdrawn.

⁵ It should be noted that the "parsers" and "scanners" in *Chan* may read secondary language text, recognize certain keywords, and provide syntax highlighting, but it is never taught that any "advanced editing functionality" is embodied or is inherent in such scanners and parsers.

⁶ As above, it should be noted that "scanners" and "parsers" are not editors and provide no *editing* functionality. In *Chan*, only the editing functionality of the primary editor is available to the user and no additional advanced editing functionality is provided by secondary editors.

Concerning rejections of claims 25 and 32 and the rejections of the dependent claims:

The only other independent claims at issue, claims 25 and 32 comprise computer program products corresponding to the methods of claims 1 and 9, respectively. Accordingly, the discussions regarding claims 1 and 9 should apply equally to claims 25 and 32, and such that Applicant respectfully requests that the Examiner withdraw the rejections of claims 25 and 32.

Even though the foregoing discussions have focused primarily on the independent claims, it will be appreciated that the dependent claims are distinguished from the art of record for at least the same reasons provided above with regard to the independent claims. Accordingly, in view of the foregoing, Applicants respectfully submit that the other rejections to the dependent claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicants acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicants reserve the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicants specifically request that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 25th day of September, 2006.

Respectfully submitted,



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